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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,731	07/28/2000	Joon Maeng	300753US8	2827
22850 7590 07/23/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TRAN, MYLINH T	
			ART UNIT 2179	PAPER NUMBER
			NOTIFICATION DATE 07/23/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

09/627,731

**Applicant(s)**

MAENG, JOON

**Examiner**

Mylinh Tran

**Art Unit**

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 17 and 19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1, 17, 19 and 23, the term of "transparent overlay" is not defined in the present specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 and 21-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohkado [US. 6,542,165].

**As per independent claims 1 and 19**, Ohkado teaches a method of displaying an electronic file to a primary user having a primary workstation, said primary workstation coupled to a global computer network, and at least one secondary viewer at a remote location, comprising:

accessing a first file and displaying contents of said first file on said primary workstation (column 5, lines 45-60);

displaying said contents of said first file at said remote location on a secondary workstation, said secondary workstation coupled to said global computer network (column 2, lines 4-7);

accessing a second file, said second file comprising information relating to said first file; and displaying first and second contents of said second file only on said primary workstation as transparent overlay to said displayed contents of first file (column 12, lines 17-50),

displaying said second contents of said second file on said secondary workstation while not displaying said file contents of said second file on said second workstation (column 2, lines 45-50).

**As per claim 2** Ohkado teaches said second file comprising annotations to the first file (column 1, lines 40-50).

**As per claim 3**, Ohkado teaches displaying said contents of said first file on another secondary workstation and said first contents of said second file being

displayed as a transparent overlay to said displayed contents of said first file on said another secondary workstation (column 3, lines 42-59).

**As per claim 4**, Ohkado teaches the first file and the second file being stored in a server computer (column 8, line 60 through column 9, line 4).

**As per claim 5**, Ohkado teaches said first file and second file being a single file, and said second file containing a code to indicate that said first contents of said second file are not for display at said secondary workstation (column 12, lines 18-50).

**As per claim 6**, Ohkado teaches said primary workstation comprising a plurality of memory units, and said first file being stored in a first memory unit and said second file being stored in a second memory unit (column 8, lines 8-20).

**As per claim 7**, Ohkado teaches said first and second contents of said second file being overlaid over said contents of said first file using means for coupling said first file and said second file (column 8, lines 8-20).

**As per claim 8**, Ohkado teaches the global computer network comprises a video conferencing system (column 2, lines 4-12).

**As per claim 9**, Ohkado teaches said primary user comprising a customer service representative and said secondary viewer comprising a customer, and said global computer network comprising the Internet (column 1, lines 15-21).

**As per claim 10**, Ohkado teaches activating said first file for editing by said at least one secondary viewer (column 5, lines 45-60).

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**As per independent claim 11**, Ohkado teaches a method of synchronous collaboration between a plurality of remote users, each of said plurality of remote users having a user workstation, each of said user workstations being interconnected via a network of interconnected computers, wherein a first one of said plurality of remote users is a host, comprising:

accessing a file for said collaboration, said file having contents having first and second states, displaying said file on said plurality of user workstations (column 10, lines 25-60), including displaying said contents stored in said second state only to said host, and to a subset of said plurality of user workstations, and displaying said data stored in said first state to said host and to all of said plurality of user workstations (column 12, lines 17-51);

enabling at least one of said plurality of remote users to edit said data stored in said first state (column 12, lines 17-51).

**As per claim 12**, Ohkado teaches the network comprising a videoconference system (column 2, lines 4-12).

**As per claim 13**, Ohkado teaches said file being stored in a location remote to any of said plurality of remote users (column 2, lines 4-10).

**As per claim 14**, Ohkado teaches the file comprising a first file and a second file, wherein said first file comprises data stored in said first state (local data), and said second file comprises data stored in said second state (remote data, column 12, lines 17-51).

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**As per claim 15**, Ohkado teaches said first file and said second file are stored in separate memory units (the first file is stored in the local memory unit and the second file is stored in the remote memory unit, column 8, lines 8-28).

**As per claim 16**, Ohkado teaches a plurality of third files, each of said plurality of third files comprising a personal file of one of said plurality of remote users (column 8, line 60 through column 9, line 5).

**As to claim 17**, Ohkado teaches transparently overlaying contents of each of said plurality of said third files over contents of said first file on respective ones of said user workstations (column 3, lines 42-49).

**As per claim 18**, Ohkado teaches a common annotation file, said common annotation file relating to said first file and accessible by more than one of said plurality of remote users (column 12, lines 17-50).

**As per claim 21**, Ohkado teaches said second file comprising an annotation of said first file (column 1, lines 40-50).

**As to claim 22**, Ohkado teaches coupling means to permit said contents of said first file and said first and second contents of said second file to be displayed on said first workstation (column 8, lines 8-20).

**As to claim 23**, Ohkado teaches said first contents of said second file being displayed as a transparent overlay to said contents of said first file on said first workstation and selected ones of the video displays but less than all of the video displays (column 12, lines 18-50).

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**As to claim 24**, Ohkado teaches said second file containing a code which correlates said second file to said first file (column 9, line 55 through column 10, line 30).

**As per independent claim 25**, it is a similar scope to claim 1; therefore, it should be rejected under similar rationale.

**As per claim 26**, Ohkado teaches a magnetic storage medium, including one of a disk and tape storage medium, and optical storage medium, a compact disk memory and a digital video disk storage medium; a nonvolatile memory storage memory; and a volatile storage medium (column 8, lines 6-35);

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkado [US. 6,542,165].

**As per claim 20**, Ohkado fail to clearly teach said first and second memory units comprising VGA memories. However, suggested that other type of memory unit is taught as Ohkado (column 8, lines 7-18). Official notice is taken that implementation of VGA memories is well known in the art of computer



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interface. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the well known implementation of VGA memories as claimed with the teaching of Ohkado. Motivation of the combination is for the advantage of efficiency of the memory unit.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mylinh Tran

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**WEILUN LO**  
**SUPERVISORY PATENT EXAMINER**